

REMARKS

The Applicant respectfully requests reconsideration of the present application in view of the above changes to the claim and the following remarks, which are responsive to the Non-Final Office Action mailed July 21, 2009.

I. Status of the Claims

In the Office Action, Claim 69 was listed as pending in the application and was rejected. As a result of this response, Claim 69 remains pending and has been amended in order to further clarify the claimed invention.

II. Claim Rejections

a. 35 U.S.C. § 101

In the Office Action Claim 69 was rejected under 35 U.S.C. § 101 as being directed toward non-statutory subject matter. (Office Action, page 2). In particular, the Office Action states that the “only recitation(s) of structure is/are of a computer within a network of computers which is/are found to be insignificant extra-solution activity ... which does not transform an unpatentable principle (e.g., Software) into a patentable process.” (*Id.*). In response, Applicant respectfully asserts that the inclusion of a computer in the claimed method is not, as stated by the Office Action, “insignificant extra-solution activity” and is, therefore, sufficient to tie the claimed process to a particular apparatus, as required to be patentable under 35 U.S.C. § 101.

In particular, the “New Interim Patent Subject Matter Eligibility Examination Instructions,” issued by the U.S. Patent and Trademark Office on August 24, 2009 (“Interim Instructions”) define “insignificant ‘extra-solution’ activity as “activity that is not central to the purpose of the method invented by the applicant.” (Interim Instructions, page 6). Applicant respectfully asserts that use of a computer to perform each of the claimed method steps is central to the purpose of the method invented and is not, therefore, merely extra-solution activity.

In support of this assertion, Applicant points to Applicant's entire specification, which makes clear that a main purpose of the claimed invention is to replicate an offline sales encounter in an online environment, which *requires* the use of computers. For example, reference is made to the following excerpts of Applicant's specification:

"A system does not exist that ... facilitates the type of interaction between the customer and the sales person that is familiar in the offline world ... The present invention addresses the current lack of *online* sales assistance by creating the infrastructure to establish a system that allows accredited, experienced and product-knowledgeable sales personnel to sell goods and services ... particularly complex, highly consultative products, more effectively *over, through, or in conjunction with online channels.*" (Applicant's Specification, page 6, line 13-page 7, line 1, *emphasis added*).

"The present invention fundamentally changes *the Internet purchasing experience* from one akin to browsing in a catalog to one similar to purchasing goods or services in the offline world[.]" (*Id.* at page 7, lines 10-12, *emphasis added*)

"The present invention allows enterprises ... to *bring their existing sales force into contact with online browsers[.]*" (*Id.* at page 8, lines 3-5, *emphasis added*)

"The system of the present invention provides SAs with interactive tools that allow them to *emulate, as closely as possible, the interaction between customers and sales personnel that are commonly accepted in the offline world.* The closer the *online experience* reflects its offline counterpart, the quicker consumers will adopt the online channel as an adjunct to existing channels." (*Id.* at page 9, lines 10-14, *emphasis added*).

As described above, and throughout Applicant's specification, use of a computer is essential to the implementation of Applicant's claimed invention. As a result, inclusion of the computer in the process claim is neither nominal nor extra-solution activity and is, therefore, sufficient to tie the claimed process to a particular apparatus.

The Office Action further states that a "general purpose computer is not a particular machine, and thus innovative software processes are unpatentable if they are tied only to a general purpose computer[.]" (Office Action, page 2). Applicant respectfully disagrees. In particular, as stated in the Interim Instructions,

For computer implemented processes, the ‘machine’ is often disclosed as a general purpose computer. In these cases, *the general purpose computer may be sufficiently ‘particular’ when programmed to perform the process steps.* Such programming creates a new machine because the general purpose computer, in effect, becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software. To qualify as a particular machine under the test, the claim must clearly convey that the computer is programmed to perform the steps of the method because such programming, in effect, creates a special purpose computer limited to the use of the particularly claimed combination of elements (i.e., the programmed instructions) performing the particularly claimed combination of functions.

(Interim Instructions, page 6, *emphasis added*).

As an example of a process claim that does constitute patent eligible subject matter, the Interim Instructions provide the following:

A method of evaluating search results, comprising ...
 sorting the results into groups based on a first characteristic;
 ranking the results based on a second characteristic; and
 comparing, using a microprocessor, the ranked results to a
predetermined list of desired results to evaluate the success of the search.

(Interim Instructions, Slide 15). According to the Interim Instructions, the “microprocessor” used in the above claim is a particular machine (and, therefore, the foregoing claim constitutes patent eligible subject matter) because “under the BRI, the step of comparing requires a particularly programmed microprocessor.” (*Id.*).

Like the example given in the Interim Instructions, the computer used to perform each of the claimed method steps of Applicant’s independent Claim 69 is a particular machine because it is particularly programmed to perform the corresponding step. The inclusion of this particular machine, therefore, provides a sufficient tie to patentable subject matter.

Based on the foregoing, Applicant respectfully asserts that Claim 69 is directed toward patentable subject matter and requests that the rejection of Claim 69 under 35 U.S.C. § 101 be withdrawn.

b. 35 U.S.C. § 112

In the Office Action, Claim 69 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. (Office Action, page 3). In particular, the Office Action maintains that “the specification does not clearly convey that the information provided to a sales associate is previously determined to be effective in closing a sale given sales associate information associated with the selected sales associate.” (*Id.*) Applicant respectfully disagrees.

In particular, Applicant respectfully asserts that support for such a recitation can be found at least on page 27, lines 1-7, and page 36, lines 1-7 of the application. However, in order to more closely resemble the language of the specification, Applicant has amended the claims, as shown above, to replace “information previously determined to be effective ...” with “best practices information to assist with ...”

Based on the foregoing, Applicant respectfully requests that the rejection of Claim 69 under § 112, first paragraph, be withdrawn.

In addition, Claim 69 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. (Office Action, page 3). In particular, the Office Action maintains that “[i]t is unclear if ... [“a computer” in lines 8, 10, 13, 18, 30, 31 and 36 of Claim 69] is relating to the computer recited in line 3 or is claiming additional 2nd, 3rd, 4th, 5th, 6th and so on ... computers.” (*Id.*). In response, Applicant has amended Claim 69, as shown above, to replace “a computer” in lines 8, 10, 13, 18, 30, 31 and 36 with “the computer,” so that “the computer” in lines 8, 10, 13, 18, 30, 31 and 36 of Claim 69 now refers to the same computer as line 3.

Based on the foregoing, Applicant respectfully requests that the rejection of Claim 69 under § 112, first paragraph, be withdrawn.

c. 35 U.S.C. § 103(a)

In the Office Action, Claim 69 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,760,429 to Hung et al. (“*Hung*”) in view of U.S. Patent No. 6,134,530 Bunting et al. (“*Bunting*”) and U.S. Publication No. 2002/0004735 to Gross (“*Gross*”). (Office Action, page 4). For at least the following reasons, Applicant respectfully requests that the rejection of Claim 69 under 35 U.S.C. § 103(a) be withdrawn.

Applicant respectfully asserts that neither *Hung* nor *Bunting* nor *Gross* teaches, suggests or renders obvious each of the recitations of Claim 69. In particular, Applicant respectfully asserts that neither *Hung* nor *Bunting* nor *Gross* teaches, suggests or renders obvious at least “retrieving, by the computer within the network of computers, from a database of collateral sales material, best practices information to assist with closing a sale given the sales associate information associated with the selected sales associate, the customer information and the one or more products the customer is searching,” as recited in Applicant’s Claim 69.

The Office Action concedes that *Hung* does not teach or suggest this recitation and, instead, relies upon *Gross*. (Office Action, page 6). Applicant respectfully asserts, however, that *Gross* does not in fact teach or suggest “retrieving ... *best practices information*.” Instead, as pointed out by the Office Action, *Gross* discloses providing “information relating to estimates of the commissions that [sales representatives] will make on a sale.” (*Id.*, citing *Gross*, paragraph [0008]). Applicant respectfully asserts, however, that “estimates of commissions” are not the same or equivalent to “best practices information,” as recited in Applicant’s Claim 69. As one of ordinary skill in the art would recognize, an estimate of a commission does not in any way relate to or indicate a best practice for completing a sales transaction. While clear on its face, support for this can also be found in Applicant’s specification. In particular, as described in Applicant’s specification:

The desktop 220 receives best practices information from the best practices data base 232 via the practices engine 230. The practices engine 230 monitors all communication, data, external information, and resources (collectively “assets”)

used by an SA during a sales encounter and for a particular product or service. All of this information is then cataloged by enterprise, vertical and/or product as well as scored based upon the outcome of each related sales interaction to formulate a set of best practices.

(Applicant's Specification, paragraph [0058]). As described, "best practices" information can include "communication, data, external information, and resources (collectively 'assets') used by an SA during a sales encounter." None of these are the same or equivalent to an estimate of a sales commission. Accordingly, *Gross*, like *Hung*, fails to teach or suggest "retrieving, by the computer within the network of computers, from a database of collateral sales material, best practices information to assist with closing a sale given the sales associate information associated with the selected sales associate, the customer information and the one or more products the customer is searching," as recited in Applicant's Claim 69. *Bunting* likewise fails to teach or suggest the above recitation of Applicant's Claim 69. In fact the Office Action relies on *Bunting* for different purposes. (Office Action, page 6).

Because none of the references alone teach or suggest "retrieving, by the computer within the network of computers, from a database of collateral sales material, best practices information to assist with closing a sale given the sales associate information associated with the selected sales associate, the customer information and the one or more products the customer is searching," as recited in Applicant's Claim 69, even if combined, the references cannot teach or suggest all of the recitations of Applicant's Claim 69.

At least for the foregoing reasons, Applicant respectfully asserts that Claim 69 is patentable over *Hung* in view of *Bunting* and further in view of *Gross*, and respectfully requests that the rejection of Claim 69 under §103(a) be withdrawn.

III. Conclusion

In light of the remarks above, Applicant respectfully submits that the application is in condition for allowance and respectfully requests that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 14-0629.

Respectfully submitted,

/Jennifer F. Miller/
Jennifer F. Miller
Registration No. 56,278

Ballard Spahr LLP
Customer Number 23859
(678) 420-9300
(678) 420-9301 (fax)